REMARKS

Upon entry of the present amendment, claims 17 and 21-30 will remain pending in the above-identified application and stand ready for further action on the merits.

The instant amendment to the claims does not introduce new matters into the application as originally filed, and does not raise new issues for the Examiner's consideration. In this regard, the amendment simply cancels prior claims 18-20 and based on disclosure at page 31, lines 21-25 of the specification amends claim 17 to recite:

> *A process for producing a catalyst component for addition polymerization, which comprises the step of contacting (a) triphenyl bismuth, (b) pentafluorophenol and (c) silica.*

As such, the instant amendment also removes issues outstanding for purposes of appeal and is thus entirely appropriate for entry under the provisions of 37 CFR § 1.116.

Enclosed 37 CFR § 1.132 Declaration

Enclosed with the instant reply is a 37 CFR § 1.132 declaration of Mr. Kazuo Takaoki, the present inventor. The purpose of Mr. Takaoki's declaration is to show that the presently claimed invention is in no way rendered obvious by the cited art references being applied in the outstanding office action under the provisions of 35 USC § 102(e) and 35 USC § 102(a). The Examiner is respectfully requested to consider Mr. Takaoki's enclosed declaration in conjunction with the following remarks, since the two together show and evidence that the presently claimed invention is both novel and non-obvious over the cited art (Ogane US '124 and Ogane DE '188) that is being applied against the pending claims in the outstanding office action.

Claim Rejections - 35 USC § 102

Claims 17 – 30 have been rejected under the provisions of 35 USC § 102(e) as being anticipated by Ogane US '124 (US 2002/0143124) and independently, under the provisions of 35 USC § 102(a) as being anticipated by Ogane DE '188 (DE 101 64 188). Reconsideration and withdraw of each of the rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (*or references when combined*) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the

proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

>> Novelty <<

The present invention uses a combination of triphenyl bismuth ($Bi(C_6H_5)_3$), pentafluorophenol (C_6F_5OH) and silica (SiO_2) as mentioned above and recited in claim 17.

Importantly, however, triphenyl bismuth is *not* disclosed in either the Ogane US '124 or Ogane DE '188 cited art reference. Consequently, it follows that the combined use of triphenyl bismuth ($Bi(C_6H_5)_3$), pentafluorophenol (C_6F_5OH) and silica (SiO_2) is *not* disclosed in either the Ogane US '124 or Ogane DE '188 reference of record.

Accordingly, neither the Ogane US '124 nor Ogane DE '188 reference of record is capable of anticipating the instant invention as claimed.

The above fact is not affected by the disclosure of pentafluorophenol (C_6F_5OH) and silica (SiO_2) in the Ogane US '124 or Ogane DE '188 reference, since all of the recited elements of claim 17 and dependent claims 21-30 (*all of which ultimately depend from claim 17*) are not present in either the Ogane US '124 or Ogane DE '188 reference.

The above fact is set forth in the below table for the Examiner's convenience and for purposes of clarity.

TABLE

	Present Invention	***Ogane US '124 & Ogane DE '188***
Compound (a)	Triphenyl bismuth ($Bi(C_6H_5)_3$)	Do Not Disclose $Bi(C_6H_5)_3$
Compound (b)	Pentafluorophenol (C_6F_5OH)	Disclose C_6F_5OH
Compound (c)	Silica (SiO_2)	Disclose SiO_2

As such, because the cited art references do not teach each of the elements present in the instant claims, they cannot anticipate any of instantly pending claims 17 and 21-30.

>> Non-Obviousness <<

As indicated above, enclosed wherewith is a 37 CFR § 1.132 declaration of the present inventor, Mr. Kazuo Takaoki. In Mr. Takaoki's declaration he compares Example 2 of the invention with a Comparative Experiment 1, which is based on Example 1 of US 2002/0143124 A1 of Ogane, and reports the results of his comparison in Table A at page 5 of the declaration.

As Mr. Takaoki states in the "Discussion and Conclusion" section (*see page 4*) of his declaration:

> "The above Comparative Experiment 1 is summarized in the following Table A together with Example 2 of the present invention.
>
> While an object of the present invention is to provide a modified particle which can form a catalyst for addition polymerization exhibiting a high polymerization activity (see the present specification, page 3) Table A shows that:
>
> - Comparative Experiment 1 using a combination "$(C_2H_5)_2Zn$ + C_6F_5OH + SiO_2" gives a polymerization activity of "290 g/g-solid catalyst component/hour" or "8.7 kg/mmol-Zr/hour"; and
>
> - Example 2 of the present invention using a combination "$Bi(C_6H_5)_3$ + C_6F_5OH + SiO_2" gives a polymerization activity of "1,500 g/g-solid catalyst component/hour" or 45 kg/mmol-Zr/hour";
>
> and therefore, the former polymerization activity is much smaller than the latter one.
>
> Accordingly, I do not think the present invention is obvious over the cited documents (U.S. 2002/0143124A1 and DE 10164188A1)."

According, based on the comparative testing results set forth in the attached declaration of Mr. Takaoki, it is submitted that each of the instantly pending claims is fully patentable over the cited references of record, being neither anticipated nor rendered obvious thereby. Any contentions of the USPTO to the contrary are respectfully requested to be reconsidered at present.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated:

Respectfully submitted,

By _____
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Enclosure: 37 CFR § 1.132 Declaration of Mr. Kazuo Takaoki